

REMARKS

Applicant's remarks are preceded by related comments from the Examiner (shown in small bold-faced type).

**DETAILED ACTION**

**3. Claims 12-21 rejected under 35 U.S.C. 112, ....**

**Claim 12, line 3, the phrase "a list of items available for sale" is not clear. No what, where or who comprise the "for sale" limitation. As is, the "for sale" limitation is practically infinite in scope. Thus, it is indefinite.**

Claim 12 has been amended to make clear that the list of items available for sale is a list of items available for sale by the use of the self-checkout apparatus. It is respectfully submitted that claims 12-21 particularly point out and distinctly claim the subject matter which applicant regards as the invention and it is respectfully requested that the Examiner withdraw the rejection under 35 USC 112 ¶ 2.

**5. Gu discloses, e.g. col. 4, non bar coded produce items whose images corresponding to a list of most frequently sold items, e.g. 30, and a graphical user interface, e.g. col. 7, lines 40-45. Gu does not specifically disclose the term product look up entry device. To have provided a product look up entry device for Gu would have been obvious to one of ordinary skill in the art. The motivation for providing such would have been to have provided the recognition software, e.g. 21, to allow a product look up when viewing all the variables each piece of produce/item creates when ascertaining what the produce/item comprises. To update the library to reflect the changing status of products sold would have been obvious to one of ordinary skill in the art. The motivation for doing such would have been allowing for current status reports, reports that are common knowledge in the art, to allow a vendor/grocer to ascertain various data to increase sales/profit margins. Applicant's REMARKS have been reviewed, but are moot in light of the new ground of rejection.**

It is noted that the Notice of References cited section of the Office Action identifies two Gu references (US 6,606,579 and US 6,409,085). Nevertheless, the Examiner, in his comments, does not specifically identify which reference is being referred to. Based on the Examiner's listing of US 6,409,085 in the "Further pertinent reference of interest" section of the Office Action it is assumed that, in ¶ 5 of the Office Action, the Examiner intends to reference the 6,606,579 patent. This assumption is further supported by the specific sections to which the examiner cites. If reference to the GU '579 patent was not what was intended, the undersigned respectfully requests that the Examiner issue a new Office Action clarifying the intended reference.

The Examiner's rejection is respectfully traversed. It is respectfully submitted that the cited sections of the '579 patent (Gu, US. Patent No. 6,606,579) do not support a rejection under § 103.

Claim 12 recites an apparatus for self-checkout of non-bar coded items that includes a processing unit that maintains a list of most frequently sold items, said list of most frequently sold items being a subset of a list of items available for sale by the use of the self-checkout apparatus and a Product Look Up (PLU) entry device having a Graphic User Interface (GUI), wherein the GUI provides display of a plurality of images corresponding to non-bar coded items and where at least one of the plurality of images is selected for display on the GUI based on the selected image's corresponding non-bar coded item being a member of the list of most frequently sold items, and wherein the entry device provides a user with means for selecting ones of the predetermined images of the non-bar coded items to indicate items for purchase by a user. Gu does not teach or suggest such an apparatus.

The Examiner, in his comments, asserts that the '579 patent discloses "a list of most frequently sold items, e.g. 30." This is not the case. Element 30 as disclosed in the '579 patent is not a list of most frequently sold items, but rather, is a classification library. The '597 patent discloses that "Classification library 30 contains reference data from previously collected and processed spectral and non-spectral produce data." ('579, col. 3, l. 65-57). The '579 patent further explains that this "reference data" in the library 30 "is device-dependent data for data reduction steps. For example, data 38 includes calibration information and pixel-to-wavelength mapping and interpolation information used in the data reduction process" ('579, col. 4, l. 1-4). The Office's suggestion that "reference data from previously collected spectral and non-spectral data" somehow corresponds to claim 12's "list of most frequently sold items" is simply not supported (particularly in light of the specific examples of such "reference data" including pixel-to-wavelength mapping and interpolation information). In short, contrary to the Examiner's comments, the Office has not shown that the prior art teaches or suggests the list of most frequently sold items as recited in claim 12.

Because the Office has not met its burden of showing that '579 patent discloses "a list of most frequently sold items", the Office's rejection under § 103 is not supported, and it is respectfully requested that the rejection be withdrawn.

The Examiner, in his comments, also fails to explain how the prior art discloses or suggests "a

Product Look Up (PLU) entry device having a Graphic User Interface (GUI), wherein the GUI provides display of a plurality of images corresponding to non-bar coded items and where at least one of the plurality of images is selected for display on the GUI based on the selected image's corresponding non-bar coded item being a member of the list of most frequently sold items, and wherein the entry device provides a user with means for selecting ones of the predetermined images of the non-bar coded items to indicate items for purchase by a user." The Examiner, in his comments, suggests that one would have been motivated to include a PLU in the system of the '579 patent. Even if this were the case, this would not be sufficient to teach or suggest all elements of claim 12. Claim 12 requires more than the simple inclusion of a PLU. What claim 12 requires is a PLU with a GUI interface that "provides display of a plurality of images corresponding to non-bar coded items and where at least one of the plurality of images is selected for display on the GUI based on the selected image's corresponding non-bar coded item being a member of the list of most frequently sold items, and wherein the entry device provides a user with means for selecting ones of the predetermined images of the non-bar coded items to indicate items for purchase by a user." The cited prior art does not disclose, and the Examiner has not suggested, the use of a GUI with a displayed plurality of images where at least one of the plurality of images is selected for display on the GUI based on the selected image's corresponding non-bar coded item being a member of the list of most frequently sold items."

For the further reason that the prior art does not teach or suggest a self-checkout apparatus including a GUI provides display of a plurality of images corresponding to non-bar coded items and where at least one of the plurality of images is selected for display on the GUI based on the selected image's corresponding non-bar coded item being a member of the list of most frequently sold items, and wherein the entry device provides a user with means for selecting ones of the predetermined images of the non-bar coded items to indicate items for purchase by a user, the rejection under § 103 is not supported, and it is respectfully requested that the rejection be withdrawn.

The Office's Reliance on allegedly "obvious" knowledge is traversed.

To the extent that the Office has or would suggest that the subject matter of providing a self-checkout apparatus including a Product Look Up (PLU) entry device having a Graphic User Interface (GUI), wherein the GUI provides display of a plurality of images corresponding to non-bar coded items and where at least one of the plurality of images is selected for display on the GUI based on the selected image's corresponding non-bar coded item being a member of the list of most frequently sold items, and wherein the entry device provides a user with means for selecting ones of the predetermined images of the non-bar coded items to indicate items for purchase by a user as recited by the claims is "obvious," the applicant respectfully traverses this suggestion. The undersigned and applicant know of no teaching or suggestion to provide a PLU with a GUI as recited by the amended claims.

It is respectfully submitted that, if any fact not shown in a cited reference is relied upon by the Office to support a claim that the subject matter is "obvious," the Office must meet the standards for the taking of Official Notice. The MPEP clearly states the standards for the Office's taking notice of alleged facts:

Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. ...

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979) ("[W]hen the PTO seeks to rely upon a chemical theory, in establishing a prima facie case of obviousness, it must provide evidentiary support for the existence and meaning of that theory."); *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.").

It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. [*In re*] *Zurko*, 258 F.3d [1379] at 1385, 59 USPQ2d [1693] at 1697 [(Fed. Cir.

2001)) (“[T]he Board cannot simply reach conclusions based on its own understanding or experience-or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”). While the court explained that, “as an administrative tribunal the Board clearly has expertise in the subject matter over which it exercises jurisdiction,” it made clear that such “expertise may provide sufficient support for conclusions [only] as to peripheral issues.” *Id.* at 1385-86, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002) (In reversing the Board’s decision, the court stated “‘common knowledge and common sense’ on which the Board relied in rejecting Lee’s application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency’s obligation. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.”).

MPEP 2144.03(A) (emphasis in original).

If it was the Office’s intention to take Official Notice of “a Product Look Up (PLU) entry device having a Graphic User Interface (GUI), wherein the GUI provides display of a plurality of images corresponding to non-bar coded items and where at least one of the plurality of images is selected for display on the GUI based on the selected image’s corresponding non-bar coded item being a member of the list of most frequently sold items, and wherein the entry device provides a user with means for selecting ones of the predetermined images of the non-bar coded items to indicate items for purchase by a user” as recited by the claims of the application, then it is respectfully submitted that, the subject matter of which the Office has taken notice is “not capable of instant and unquestionable demonstration as being well-known,” *id.*, and that the undersigned knows of no manner for instantly and unquestionably demonstrating that such subject matter is well known. Further, it is submitted that, to the extent the Office did take such notice, the Examiner appears to have relied on his understanding of “‘common knowledge’ in the art . . . as the principal evidence upon which a rejection was based,” *id.*, which in accordance with the MPEP it is inappropriate to do “without evidentiary support in the record,” *id.*

The MPEP, furthermore, states the requirements for an Examiner’s continued reliance on personal knowledge after such traverse:

Application No. 09/710,137  
Reply to Office Action of May 12, 2005

If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

*Id.*

Applicant respectfully submits that, to the extent the Office's rejection is based on assertions that a fact is well-known or is common knowledge in the art, such assertions have been made without sufficient documentary evidence. Applicant respectfully suggests that the Office's "obviousness" assertions are not "capable of instant and unquestionable demonstration as being well-known," MPEP 2144.03(A), and have been appropriately traversed.

Claims 13-21 depend from claim 12 and are patentable for at least the same reasons stated with respect to claim 12.

The Office Action Is Incomplete And Should Be Withdrawn and Reissued Unless All Claims Are Allowed.

The Examiner, in his comments, fails to address the patentability of claims 13-21. This is clearly improper. As required by MPEP 707.07, the examiner's action is to be complete as to all matters. Because the Examiner has failed to address these claims 13-21, the undersigned does not know of any reason for the Office's continuing rejection of the claims, and the May 12, 2005 Office Action is deficient.

It is respectfully submitted that the Office should either allow all pending claims for the reasons set forth with respect to claim 12 or, if the Office does not allow the claims, a new Office Action should be issued in which the Examiner provides a complete action addressing all pending claims.

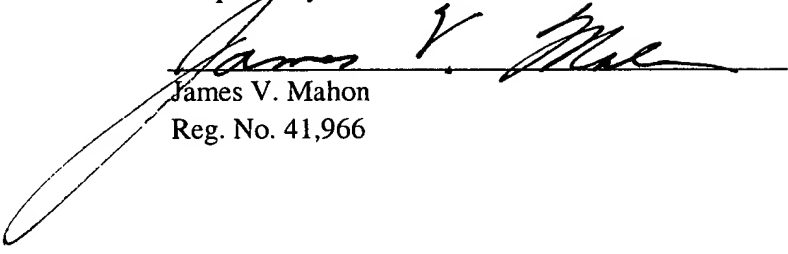
Application No. 09/710,137  
Reply to Office Action of May 12, 2005

CONCLUSION

Claims 12-21 are now pending and believed to be in proper form for allowance.  
Please apply any credits or excess charges to our deposit account number 50-0521.

Date: June 20, 2005

Respectfully submitted,

  
James V. Mahon  
Reg. No. 41,966

MAILING ADDRESS  
Clifford Chance US LLP  
31 West 52<sup>nd</sup> Street,  
New York, NY 10019-6131